

UNITED STATES DISTRICT COURT  
WESTERN DISTRICT OF WASHINGTON  
AT SEATTLE

PAUL N. NELSON,

Plaintiff.

V.

## K2 INC. and K-2 CORPORATION,

## Defendants.

No. C07-1660RSL

ORDER GRANTING DEFENDANTS'  
MOTION FOR SUMMARY  
JUDGMENT UNDER 35 U.S.C. § 102(b)

This matter comes before the Court on “K2’s Motion for Summary Judgment.”

Dkt. # 52. Defendants argue that United States Patent No. 5,603,522 (the ‘522 patent) is invalid because plaintiff sold skis made in accordance with its claims more than a year before the effective filing date of the patent application. Plaintiff asserts that his sales were primarily for purposes of experimentation and therefore are not evidence that the invention was “on-sale” before September 23, 1993.<sup>1</sup>

On October 15, 2008, the Court determined that the claims of the '522 patent were entitled to the benefit of a September 23, 1994, application filing date. Dkt. # 50. An inventor is

<sup>1</sup> Defendants argue that another manufacturer also sold skis within the scope of all three claims of the ‘522 patent. Because plaintiff’s sales trigger the § 102(b) bar, the Court need not determine whether defendants have shown by clear and convincing evidence that the RD Fat Dog embodied every limitation of the claims of the ‘522 patent.

1 not entitled to a patent, however, if the invention was on sale more than one year prior to the date  
2 of the patent application. 35 U.S.C. § 102(b). The “on-sale” bar applies if the invention (i) was  
3 the subject of a commercial sale or offer of sale and (ii) was ready for patenting, meaning that the  
4 invention had been reduced to practice or was the subject of drawings or other descriptions that  
5 would enable a person skilled in the art to practice the invention. Pfaff v. Wells Elecs., Inc., 525  
6 U.S. 55, 67 (1998). Plaintiff challenges both prongs of the Pfaff test.

7 **A. Commercial Sale or Offer of Sale**

8 Although an inventor is generally barred from removing existing knowledge from  
9 public use, he “may conduct extensive testing without losing his right to obtain a patent for his  
10 invention – even if such testing occurs in the public eye.” Pfaff, 525 U.S. at 64. Thus, the on-  
11 sale bar is triggered only by commercial sales of the invention. When determining whether a  
12 particular sale was for commercial or experimental purposes, the Court should consider a variety  
13 of factors, including:

14 (1) the necessity for public testing, (2) the amount of control over the experiment  
15 retained by the inventor, (3) the nature of the invention, (4) the length of the test  
16 period, (5) whether payment was made, (6) whether there was a secrecy obligation,  
17 (7) whether records of the experiment were kept, (8) who conducted the  
18 experiment, . . . (9) the degree of commercial exploitation during testing[,] . . .  
19 (10) whether the invention reasonably requires evaluation under actual conditions  
of use, (11) whether testing was systematically performed, (12) whether the  
inventor continually monitored the invention during testing, and (13) the nature of  
contacts made with potential customers.

20 EZ Dock v. Schafer Sys., Inc., 276 F.3d 1347, 1357 (Fed. Cir. 2002) (Linn, J., concurring). The  
21 focus of the inquiry is not whether the invention was still under development or subject to  
22 improvement at the time of an asserted sale. Instead, the issue is whether the primary purpose of  
23 each transaction was to conduct experimentation. See Allen Eng’g Corp. v. Bartell Indus., Inc.,  
24 299 F.3d 1336, 1354 (Fed. Cir. 2002) (citations omitted).

25 The Court recognizes that plaintiff is an individual, not a large corporation, and  
26

1 takes his comparative resources into consideration when evaluating the primary purpose of the  
2 1992-93 transactions. In particular, the Court assumes that full-scale experimentation would  
3 likely be beyond plaintiff's means and that there would be a greater-than-normal need to obtain  
4 timely financial remuneration from his invention. Lough v. Brunswick Corp., 86 F.3d 1113,  
5 1121 (Fed. Cir. 1996). Nevertheless, the basic elements of an experimental program must be  
6 present to avoid the public use bar: “[t]he law does not waive statutory requirements for  
7 inventors of lesser sophistication.” Id. at 1122.

8 Defendants, as the parties asserting patent invalidity, have the burden of proving by  
9 clear and convincing evidence that the patent was in public use before September 23, 1993.  
10 Defendants have submitted evidence of, and plaintiff has acknowledged, sales of the patented  
11 skis under the name MAX F/X before September 23, 1993. Once a *prima facie* case of public use  
12 has been made, the patentee must come forward with “convincing evidence” of experimental use  
13 to counter that showing.” Lisle Corp. v. A.J. Mfg. Co., 398 F.3d 306, 1316 (Fed. Cir. 2005)  
14 (quoting TP Labs., Inc. v. Professional Positioners, Inc., 724 F.2d 965, 971 (Fed. Cir. 1984)).  
15 Plaintiff argues that all of the pre-September 23, 1993, sales fall within the experimental use  
16 exception to the on-sale bar because (a) public testing and evaluation under real world conditions  
17 was necessary, (b) a survey was included with each pair of skis, (c) plaintiff actively sought  
18 feedback from a number of purchasers, and (d) design revisions were made based on user  
19 feedback.

20 “[A] single sale or offer of sale suffices to bar patentability.” Electromotive Div. of  
21 Gen. Motors Corp. v. Transp. Sys. Div. of Gen. Elec. Co., 417 F.3d 1203, 1209 (Fed. Cir. 2005).  
22 Because the Court must conduct an “objective evaluation of the facts surrounding the  
23 transaction” in order to determine whether the primary purpose of the inventor was to conduct  
24 experimentation, the details of two transactions will be evaluated in the larger context of

1 plaintiff's activities during the 1992-93 ski season. Id. at 1210.<sup>2</sup> The first transaction involves a  
2 consignment and sale with Sportsman, a shop in Bellingham, Washington. According to the  
3 evidence provided, plaintiff's wife, Coni Nelson, began contacting Sportsman in September 1992  
4 to see if they were interested in carrying the MAX F/X skis. Decl. of Coni Nelson, Ex. B. The  
5 shop agreed to take a pair of skis on consignment. They were delivered to Sportsman in October,  
6 along with a copy of plaintiff's user survey. The terms of the consignment were as follows: "If  
7 no interest has been generated in this ski and the ski has not been sold ODYSSEY SKIS can  
8 request ski to be returned or consignment amount of \$380.00 after 60 days. To be evaluated  
9 12/7/92." Motion at Ex. 4. On or about December 30, 1992, Ms. Nelson's notes indicate that  
10 "someone called to ask where to mount bindings cause ODYSSEY sold." Ms. Nelson sent an  
11 acknowledgment of sale and received payment for the skis.

12 The second transaction is reflected in an invoice to Richard W. Smith, dated  
13 November 22, 1992. Motion at Ex. 6. Mr. Smith apparently purchased a pair of MAX F/X skis  
14 at retail for \$332.50. They were shipped to him in East Hampton, New York, and the balance  
15 was paid by check within the month. Other than a notation on the invoice that the "binding paper  
16 jig" could be found in the "brake wire package," there are no terms or conditions associated with  
17 this sale.<sup>3</sup> The Court is willing to assume, based on Coni Nelson's declaration, that the skis were  
18 shipped with a copy of the user survey. Decl. of Coni Nelson at ¶ 5.

19 Plaintiff and his wife assert, without even attempting to address each sale  
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21 <sup>2</sup> The transactions, one from Coni Nelson's sales notes and one from the invoices attached to  
22 defendants' motion, were not chosen for any particular reason. The Court suspects that a similar  
23 analysis could be made with regards to most of the transactions revealed by the record.

24 <sup>3</sup> What appears to be an extraneous note is included on Mr. Smith's invoice. A post-it (or at  
25 least a small rectangular paper) was placed on the invoice before photocopying. The post-it originally  
26 said "45 skis sold" with the "5" overwritten by a darker "7." Based on representations and explanations  
presented during oral argument, the Court assumes that the total number of skis sold during the 1992-93  
ski season was 47 pairs.

1 individually, that all of the transactions during this period were part of a “testing and evaluation”  
2 program. Decl. of Paul Nelson at ¶ 5; Decl. of Coni Nelson at ¶ 4. The contemporaneous  
3 evidence does not support these statements, and “the expression by an inventor of his subjective  
4 intent to experiment, particularly after institution of litigation, is generally of minimal value.”  
5 Lough, 86 F.3d at 1122. A series of newspaper articles written between December 1992 and  
6 February 1993 shows that plaintiff was actively marketing the MAX F/X for consumer use during  
7 the 1992-93 ski season.<sup>4</sup> According to the articles, plaintiff received orders from eight Western  
8 Washington stores, was taking orders from individual skiers, and was working toward  
9 manufacturing twenty pairs of skis per week. In the December 30, 1992, article, readers were  
10 invited to order their own pair of MAX F/X skis by calling the phone number provided. There is  
11 no indication that plaintiff was seeking “testers” for the skis or was conducting experiments  
12 before making his invention available to the public. Rather, his statements to the reporters and  
13 the existence of the articles themselves show a concerted effort to bring the invention to market  
14 immediately. Ms. Nelson’s sales notes support this conclusion. They show that plaintiff was  
15 trying to convince a number of ski shops around the country to carry the MAX F/X. If an  
16 outright sale was not in the offing, plaintiff would agree to a consignment, demonstration, or loan  
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19 <sup>4</sup> Although plaintiff submitted these articles with its opposition and defendants have not  
20 objected, the Court has considered possible hearsay problems associated with the newspaper articles.  
21 Plaintiff’s out-of-court statements are admissible because they are either admissions of a party opponent  
22 or are not offered for the truth of the matter asserted (*i.e.*, not offered to prove that the Nelsons were  
23 making twenty pairs of skis per week, but rather to show state of mind). The reporters’ repetition of  
24 those statements, however, are out-of-court declarations by a non-party offered for the truth of the  
25 matter asserted. The Court finds that in the extraordinary circumstances presented here, the articles are  
26 admissible under Fed. R. Ev. 807. First, the inventor’s intent and actions during the 1992-93 season are  
material. Second, the recorded recollections, offered by plaintiff to the Patent and Trademark Office  
and this Court, are the best evidence available of what was said and done fifteen years ago. And finally,  
the general purposes of the hearsay rules and the interests of justice are best served by admission of  
these remarkably similar news reports regarding a critical, and distant, time period. See, e.g., Larez v.  
City of Los Angeles, 946 F.2d 630, 643-44 (9th Cir. 1991).

1 of some sort to give people a chance to try the wide short ski. None of the notes suggests that  
2 plaintiff intended to retain control of the skis after sale or that the shops or end-users would be  
3 required to do any tests or experiments with the skis.

4 The Sportsman transaction does not vary from this pattern. Ms. Nelson offered the  
5 MAX F/X with no strings attached. There is no indication that the skis were being offered for  
6 testing purposes or that there were any requirements or limits on how the skis could be used after  
7 purchase. The terms of the consignment did not require Sportsman or the ultimate consumer to  
8 conduct any particular test with or experiment on the skis, to keep records of any testing, to  
9 maintain the confidentiality of the invention, or to submit a report to plaintiff. Plaintiff retained  
10 no control over the invention except a right of return if payment were not made. The skis were  
11 apparently sold by Sportsman to an individual unknown to plaintiff and with whom he had no  
12 contact. The Smith transaction is even more bare-bones, with few terms other than price and  
13 shipping information specified between the parties. In both transactions, the skis were conveyed  
14 to apparent strangers, there was no provision for plaintiff's subsequent involvement in the  
15 assessment of the product, and plaintiff retained no supervision or control over the skis after they  
16 left his shop: it cannot reasonably be asserted that plaintiff's use of the invention during this time  
17 period was "experimental." See Lough, 86 F.3d at 1121.

18 Plaintiff relies heavily on the fact that every recipient of the MAX F/X ski received  
19 a questionnaire and was asked to provide information regarding the performance of the invention.  
20 Decl. of Coni Nelson at ¶ 5. Plaintiff argues that because skis are best tested in real world  
21 conditions by a number of skiers, public use coupled with a questionnaire was a necessary step in  
22 developing the invention. Although user testing would undoubtedly be helpful in the  
23 development of a ski, that fact does not tell us whether the 1992-93 sales were commercial or  
24 experimental in nature. Plaintiff had filed a patent application regarding a wide short ski as early  
25 as 1991, and the record shows activity during that time frame that could support a finding of

1 “experimentation.” See Decl. of Paul Nelson, Ex. A (1991 confidentiality agreements with  
2 Research Dynamics and Salomon N. America for the review of the invention). The issue before  
3 the Court is whether the “primary purpose of the inventor at the time of sale, as determined from  
4 an objective evaluation of the facts surrounding the transaction, was to conduct experimentation.”  
5 Allen Eng’g, 299 F.3d at 1354 (quoting EZ Dock, 276 F.3 at 1356-57 (emphasis added)).

6                   Given the total lack of control retained by plaintiff and the balance of the remaining  
7 EZ Dock factors (276 F.3d at 1357), it is clear that the 1992-93 season sales were commercial in  
8 nature despite the dissemination of the questionnaire. Manufacturers often include user surveys  
9 with products that are unquestionably “sold:” requests for feedback do not, without more,  
10 suggest “experimentation.” The fact that plaintiff had an interest in improving his product and  
11 requested input from his customers regarding their likes and dislikes did not make those  
12 customers “testers” and did not change the market sales reflected in the record (including those to  
13 Sportsman and Mr. Smith) into experiments.<sup>5</sup> The purchasers were under no obligation to  
14 complete the survey or communicate with plaintiff in any way: it appears that two-thirds of the  
15 purchasers declined to provide any feedback at all. The 1992-93 sales and evaluations were not  
16 part of an effort to ensure that the invention would serve its intended purpose: plaintiff was  
17 already marketing the MAX F/X as broadly as possible, with no requirements or limitations  
18 imposed on the users. Plaintiff made no effort to maintain control or secrecy over the invention  
19 after transferring the skis to shops like Sportsman and people like Mr. Smith. Skis were sold at  
20 market rates, no testing regimen was developed, and no experiments were performed. In these  
21 circumstances, typical commercial sales activities, such as the inclusion of consumer surveys  
22 with the product, are insufficient to establish an experimental relationship.

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24                   <sup>5</sup> It is undisputed that plaintiff made modifications to the MAX F/X ski following the 1992-93  
25 ski season. There is no evidence, however, that these changes were a response to consumer comments  
26 contained in the surveys or were otherwise prompted by the “experimentation” allegedly performed  
during 1992-93.

1                   Defendants have shown by clear and convincing evidence that at least one sale  
2 made prior to September 23, 1993, was a commercial sale and not primarily for the purpose of  
3 experimentation. The first prong of the Pfaff test is satisfied.

4 **B. Ready for Patenting**

5                   An invention is reduced to practice if the inventor has constructed an embodiment  
6 that meets all of the limitations of the claim and has determined that the invention works for its  
7 intended purpose. Cooper v. Goldfarb, 154 F.3d 1321, 1327 (Fed. Cir. 1998). Plaintiff asserts  
8 that he “did not have a definite and permanent idea of the complete scope of my invention until I  
9 began the development of my MAX F/X III ski in December of 1993.” Decl. of Paul Nelson at  
10 ¶ 11. Nevertheless, it is clear that plaintiff manufactured at least forty pairs of skis that fell within  
11 the scope of the three claims of the ‘522 patent. By marketing and selling these skis to the public,  
12 plaintiff showed that he was confident that the skis would work for their intended purpose. The  
13 invention was ready for patenting during the 1992-93 season.

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15                   For all of the foregoing reasons, defendants’ motion for summary judgment is  
16 GRANTED. The Clerk of Court is directed to enter judgment in favor of defendants and against  
17 plaintiff.

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19                   Dated this 5th day of February, 2009.

20                     
21                   Robert S. Lasnik  
22                   United States District Judge